

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Lawrence E. Williams III

Serial No.: 09/748,729

Filed: December 26, 2000

For: *Methods and Systems for Providing Life Management and Enhancement
Applications and Services for Telematics and Other Electronic Medium*



Confirmation No. 4226

Examiner: Zurita, James H.
Art Unit: 3625

Atty Docket No. 75000-276046
(NET-001 CIP)

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via facsimile to (571) 273-8300, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 31, 2006.

By: Bobbie Juras
Bobbie Juras

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final Office Action mailed October 31, 2005 for which a response is due January 31, 2006. No amendments are being filed with this request. The Commissioner is authorized to charge any required fee to Pillsbury Winthrop Shaw Pittman LLP's deposit account no. 03-3975 (order no. 075000-0276046).

This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated on the attached sheets.

Respectfully submitted,
PILLSBURY WINTHROP LLP

Date: January 31, 2006

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REMARKS

Upon entry of the Amendment filed January 3, 2006,¹ claims 34-45 remain pending in the application. Claim 34 is the sole independent claim and requires, *inter alia*,

accessing the telematics device embedded in the customer vehicle during the emergency associated with the customer vehicle;

retrieving the emergency contact information of the customer from the virtual garage using the telematics device; and

transmitting the emergency contact information of the customer to a Public Safety Answering Point, wherein the emergency contact information is transmitted from the telematics device embedded in the customer vehicle to the Public Safety Answering point.

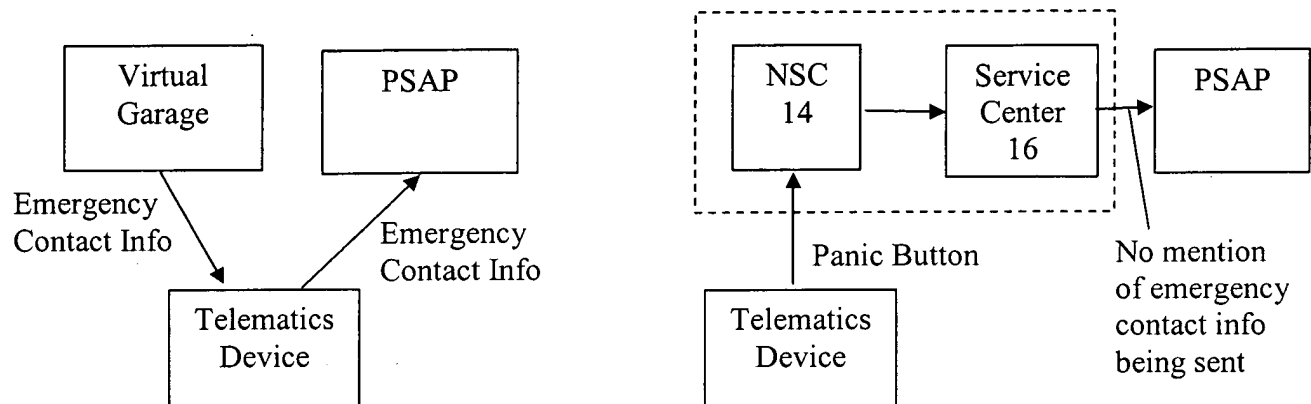
Applicant respectfully maintains that the Examiner has failed to establish a **prima facie** **case** of obviousness, because the cited references, alone or in combination, fail to disclose or suggest this subject matter.

Neither Kennedy nor Clifford, Alone or In Combination, Disclose or Suggest All Claim Limitations

Independent claim 34 stands rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,535,743 to Kennedy III et al. ("Kennedy") in view of "Clifford enters telematics with net-based car PC," TWICE Vol. 15, Iss. 3, p. 40 (Jan. 24, 2000) ("Clifford"). However, because Kennedy and Clifford, alone or in combination, do not meet all the limitations of independent claim 34, the Examiner has not established a **prima facie** case of obviousness. MPEP 2143.03.

¹ Applicant appreciates the Examiner's indication in the Advisory Action mailed January 18, 2006 that the Amendment was entered to remove claim objection and 112 first paragraph rejection issues. Applicant respectfully submits that the 112 second paragraph rejections should also be removed, and requests clarification thereof. However, since these rejections were of dependent claims 41 and 42, a discussion thereof is not considered necessary.

To further highlight and clarify the differences between the requirements of claim 34 and the cited prior art, as will be explained in more detail below, consider the following diagram:

Kennedy / Clifford

In summary, the claims require emergency contact information to be retrieved by the telematics device and transmitted from the telematics device to a PSAP during an emergency. On the other hand, Kennedy requires a NSC 14 to transmit information to an “appropriate” service center 16, and the service center 16 then transmits information to a PSAP. Clifford mentions only a single “call center” (as indicated by the dotted-line box), which relays information to a PSAP. Moreover, in neither event does Kennedy or Clifford disclose providing emergency contact information to a PSAP.

The Office Action does not even allege that Clifford discloses transmitting **anything** from a telematics device to a PSAP, instead relying solely on Kennedy for this subject matter.

However, Kennedy does not disclose or suggest that mobile unit 12 (the alleged telematics device) can transmit **anything at all** to a PSAP, much less the emergency contact information that is also **not disclosed** by Kennedy. Instead, Kennedy merely discloses that in certain “operations,” the mobile unit 12 can exchange data **with a service center 16**. (note that

even at col. 13, lines 1-20, Kennedy does not explicitly mention that unit 12 can send any data to service center 16, except perhaps menu selections on a user interface 24).

However, during an emergency, Kennedy explicitly requires the service center 16 (i.e. not the mobile unit 12), to contact emergency personnel and to provide information about the vehicle to them. As set forth in column 15, lines 35-44, Kennedy teaches that, in response to an “emergency assistance button” being pressed: “NSC 14 then provides to the appropriate service center 16 a precise vehicle location and previous travel direction of mobile unit 12, as well as the color, make, model, and license number of the vehicle associated with mobile unit 12. Service center 16 may then effectively dispatch personnel to assist the operator of mobile unit 12.”

Moreover, Kennedy teaches that service center 16 is comprised of servers, “personnel, businesses, or any other suitable provider of enhanced services.” (col. 9, lines 15-16). Kennedy does not explicitly mention that personnel in service center 16 must call 911 or other services (i.e. use manual steps and intervention) to render emergency assistance, but that is the most likely scenario, and in any event, Kennedy does not explicitly disclose any other scenarios.

Neither Kennedy Nor Clifford Teaches Retrieving Emergency Contact Information Using A Telematics Device

The Office Action admits that Kennedy does not disclose this subject matter and relies on Clifford instead. As set forth above, Clifford does not suggest transmitting anything from a telematics device to a PSAP, as the Examiner admits. As set forth below, Clifford does not suggest retrieving anything using a telematics device either.

Clifford merely teaches a “telematics product called the MobileTrace 1” that is essentially a black box with built-in GPS and modem. The MobileTrace 1 has a “panic button.” When pressed, the box contacts a live call center and provides the vehicle location. In addition, the call center has a user profile of the driver, and the call center can notify police, a hospital and a doctor.

Clifford merely discloses that the personal profile information includes a person’s heart condition. It does not explicitly disclose storing emergency contact information. However,

since the one sentence in Clifford including “your hospital and doctor” is ambiguous, Applicant will not address this lack of teaching for the sake of argument.²

In any event, nowhere does Clifford teach the explicit step of **retrieving the emergency contact information of the customer from the virtual garage using the telematics device**. Rather, Clifford clearly requires the call center to provide information to emergency services, and so it is completely unnecessary for the black box to retrieve this information. Similarly, Kennedy requires a service center 16 to provide information to emergency services. Accordingly, the alleged combination of Kennedy and Clifford requires supplying information from a call center or service center to emergency services, and so the alleged combination **teaches away** from **retrieving emergency contact information using a telematics device** because it would be completely unnecessary.

Simply put, why would one skilled in the art be motivated to change Kennedy and Clifford to allow a telematics device to obtain information that is allegedly already known by a call/service center and that the call centers use to contact emergency services? And why would one skilled in the art modify Clifford to send contact information to a PSAP instead of using this information directly (i.e. to allegedly notify a doctor or hospital)? Only hindsight reconstruction of Applicant’s invention would motivate one to make such changes.

Retrieving Emergency Contact Information, and Transmitting This To A PSAP Using A Telematics Device Is A Non-Obvious Change Of Kennedy And Clifford

Even though the Examiner fails to establish a **prima facie** case of obviousness, Applicant further addresses reasons why the alleged combination of Kennedy and Clifford would not have suggested the invention as claimed in independent claim 34.

Importantly, further modifications would be required to the alleged combination of Kennedy and Clifford to allow a telematics device to retrieve emergency contact information and transmit this to a PSAP. Apparently, the Examiner takes the position that this further modification would be obvious because “a customer may wish to have his doctor be alerted that

² Kennedy also merely discloses that NSC 14 / service center 16 can provide emergency services with “relevant medical information about the operator of mobile unit 12” and “personal medical data.” col. 15, lines 7-19. Applicant maintains that this does not suggest providing emergency contact information.

an emergency has taken place that may require the doctor's service." Applicant respectfully disagrees with this position.

First, Clifford already discloses a system in which a call center allows a "doctor to be alerted that an emergency has taken place." Accordingly, the Examiner's alleged motivation to change Clifford is contradicted by Clifford itself, which renders it unnecessary for a telematics device to retrieve and transmit doctor information (i.e. the call center already has this information and allegedly uses it to notify a doctor).

Moreover, further contrary to the Office Action, it is not obvious to supply contact information from a telematics device to a PSAP, as is further explicitly required by the claims and not taught or suggested by either Kennedy or Clifford. As repeatedly demonstrated by the Examiner's cited prior art, all previous systems rely on a call center to call and provide information to a PSAP. Accordingly, the prior art is filled with multiple teachings away from the requirements of the claims.

No Other Cited Prior Art Cures the Deficiencies of Kennedy and Clifford With Respect to Independent Claim 34

Claim 37 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of "InfoGation Corp. Introduces Productivity, Navigation, Safety and Communication Software Applications for Next-Generation Smart Car Systems," PR Newswire, Jan. 8, 1998 ("InfoGation"). InfoGation merely discloses an emergency roadside assistance system that connects a driver with a live operator and also allows access by a driver to personalized information using FM. Claim 40 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of U.S. Patent No. 6,028,537 to Suman et al. ("Suman"). Suman merely discloses an emergency roadside assistance system in which on-board information is transmitted to a service center, and the service center handles contacting emergency personnel. Claims 41-42 and 44 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of "Ford to Bring Internet to Millions of Vehicles," PR Newswire, Jan. 9, 2000 ("Ford"). Ford merely discloses a vehicle system that allows drivers to monitor e-mail and other Internet content, and also includes an emergency button.